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EXAMINER

NAJARIAN, LENA

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/816,152

Filing Date: March 26, 2001

Appellant(s): KNAUS ET AL.

James Remenick
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/12/06 appealing from the Office action
mailed 9/23/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. However, the Examiner respectfully submits that 09/822,261 is a co-pending application, not a continuation of the instant application as stated by Appellant.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2001/0041991 A1	SEGAL et al.	11-2001
US 2001/0037219 A1	MALIK	11-2001
4,827,508	SHEAR	5-1989
5,307,262	ERTEL	4-1994
6,283,761	JOAO	9-2001

Baker, D. B. "PCASSO: A Model for Safe Use of the Internet in Healthcare" Journal of AHIMA, March 2000, pp. 33-36

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections

Claim 37 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In particular, it is not clear to the Examiner which aspects of the method Applicant is seeking to further define.

Claim Rejections - 35 USC § 112

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 recites a model in the preamble. However, the body of the claims appears to be directed to a method. It is unclear what Applicant seeks patent protection for. Clarification is required.

Claim Rejections - 35 USC § 101

Claim 40 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

Claim 40 appears to be directed toward a business model. However, it is unclear as to which recognized statutory class of invention the "business model" of claim 40 is directed. In particular, a "business model" is not a process or method, as it lacks a series of steps. A "business model" is not a machine or system, as there is no specific recitation of machine or system components. A "business model" is not recognized as a composition of matter. A "business model" per se is merely a description of the operations of a business. Since these descriptions are typically fixed in some tangible medium (e.g., paper), a possible category for a "model" may be "article of manufacture". However, if the claimed business model fails to qualify as an "article of manufacture",

the business model is merely a collection of data, which is not suitable for patent protection under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11, 17, 30, 34-47, 51-55, and 57-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Segal et al. (US 200110041991 A1).

(A) Referring to claim 1, Segal discloses a broad-band, computer-based networked system comprising (Fig. 1 and para. 11 of Segal):

a collection of patient-based electronic medical records containing medical information of a plurality of persons wherein (para. 106 and para. 137, lines 3-6 of Segal):

the medical records are obtained and electronically compiled from a plurality of sources (para. 13 of Segal; the Examiner interprets "physician offices and facilities such as hospitals" to be a form of "sources");

one or more medical records of the collection possess a characteristic of non-repudiation such that the medical information contained within said medical records is verified as accurate and correct (para. 6, para. 8, and para. 131 of Segal);

the medical record of a person is transmissible in whole or in part only to that person and others authorized by that person (para. 15 and para. 27 of Segal);

each medical record can be supplemented with additional information (para. 6 of Segal; the Examiner interprets "appended and updated" to be a form of "supplemented");

and additional medical records for additional persons may be added to the collection (para. 74 and para. 26 of Segal; the Examiner interprets "registers" to be a form of "added" and "plurality of patients" to be a form of "persons");

a secure access for allowing each person to access only their own medical record (para. 26 of Segal); and

at least another secure access for allowing said others authorized to access only that person's medical record (para. 28, lines 1-6 of Segal).

(B) Referring to claim 2, Segal discloses wherein said medical records are electronically complied by direct input or digital scanning of written information into a computer-readable format (para. 23 of Segal).

(C) Referring to claim 3, Segal discloses wherein the sources are selected from the group consisting of hospitals, clinics, physician's offices, pharmacies and combinations thereof (para. 13 of Segal).

(D) Referring to claim 4, Segal discloses wherein said medical records are transmissible through the Internet (para. 21 of Segal).

(E) Referring to claim 5, Segal discloses wherein the medical record for each person contains one or more of: a table of contents an index, a source notation for information contained within the medical record, an electronic search tool, annotations for errors, linked annotations for errors, treatment options, health care choices, verification standards and news items relevant to the information in the medical record (para. 138 of Segal).

(F) Referring to claim 6, Segal discloses wherein the secure access and the another secure access comprise passwords or encryption keys (para. 103 of Segal).

(G) Referring to claim 7, Segal discloses wherein the others authorized are selected from the group consisting of physicians, nurses, hospitals and health care institutions (para. 27, lines 1-10 of Segal).

(H) Referring to claim 8, Segal discloses wherein all of the medical records of the collection possess the characteristic of non-repudiation (para. 8, para. 137, and para. 131 of Segal).

(I) Referring to claim 9, Segal discloses wherein said non-repudiated medical record is primary for treatment of a person to whom said non-repudiated medical record pertains (para. 5 of Segal).

(J) Referring to claim 10, Segal discloses wherein each medical record is certified as accurate (para. 8 of Segal).

(K) Referring to claim 11, Segal discloses wherein the medical information of each certified medical record is certified by a person to whom the medical record pertains, by the source from which said each medical record was obtained, by a system provider or by a combination thereof (para. 131 and para. 8 of Segal).

(L) Referring to claim 17, Segal discloses a fee which is assessed for maintenance of a medical record (para. 103 of Segal).

(M) Referring to claim 30, Segal discloses a method for creating an accessible electronic medical records database comprising (see abstract of Segal):

obtaining and compiling a medical record pertaining to a patient (para. 13 of Segal);

determining accuracy and correctness of medical information within each medical record (para. 8 of Segal);

electronically inputting said medical information within each medical record into a secure computer database containing other medical records (para. 23, para. 36, para. 84, and para. 137 of Segal); and

allowing said patient and those authorized by said patient access to said patient's medical record wherein access to all other medical records is blocked (para. 28, lines 1-6 of Segal).

(N) Referring to claim 34, Segal discloses updating the medical record database with additional medical information pertaining to said patient (para. 6 of Segal).

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(O) Referring to claim 35, Segal discloses securely transmitting all or part of said patient's medical record to a third party as designated by said patient (para. 15 of Segal, the Examiner interprets "distribution" to be a form of "transmitting")

(P) Referring to claim 36, Segal discloses displaying said medical record pertaining to a patient (para. 23 of Segal).

(Q) Referring to claim 37, Segal discloses an electronic database of medical records created and compiled, wherein the medical information contained with said medical records is more accurate and correct as compared to those sources from which the medical records were obtained (para. 21, para. 22, para. 8, and para. 13 of Segal).

(R) Referring to claim 38, Segal discloses a database which contains the entire medical history of at least one person (para. 13 and para. 5 of Segal; the Examiner interprets "complete" to be a form of "entire").

(S) Referring to claim 39, Segal discloses wherein each medical record is remotely accessible in whole or in part only by the patient to whom the medical record pertains and those authorized by said patient (para. 23, para. 26, and para. 28, lines 1-6 of Segal).

(T) Referring to claim 40, Segal discloses a business model comprising operating and maintaining a secure database of medical records containing medical information of many persons obtained from a plurality of sources whereby each medical record is accessible through transmission pathways and only by the person to whom the

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medical record pertains and those authorized by said person, and accuracy and correctness of the medical information within at least one medical record is determined to be as good or better than exists at the source from which said at least one medical record was obtained (para. 137, lines 1-6, para. 13, para. 15, para. 27, para. 8, and para. 21 of Segal).

(U) Referring to claim 41, Segal discloses a method for integrating medical records to create a certified medical record database comprising (para. 8 and para. 131 of Segal; the Examiner interprets "quality assurance" to be a form of "certified"):

obtaining medical information from one or more healthcare sources for a plurality of patients (para. 13 of Segal);

electronically inputting all of the medical information obtained into a secure computer database to create medical records (para. 23 of Segal); and

certifying that each of said medical records meet one of a plurality of certification standards established by a service provider to create the certified medical record database (para. 131 of Segal).

(V) Referring to claim 42, Segal discloses wherein any one of the certified medical records can be transmitted only to the patient to whom the record pertains or those authorized by said patient (para. 28, lines 1-6 of Segal).

(W) Referring to claim 43, Segal discloses wherein the plurality of certification standards are selected from the group consisting of self-certification, certification by the service provider and combinations thereof (para. 131 of Segal).

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(X) Referring to claim 44, Segal discloses a step whereby said patient obtains an analysis of the medical record (para. 23 of Segal).

(Y) Referring to claim 45, Segal discloses providing said certified medical record database with the characteristic of non-repudiation (para. 8 and para. 131 of Segal).

(Z) Referring to claim 46, Segal discloses a computer system for management of patient-based medical records comprising (see abstract of Segal):

a database of medical records pertaining to one or more subjects (para. 23 and Fig. 1, item 110 of Segal);

a receiver for receiving the medical information pertaining to said medical records from one or more senders (para. 13 of Segal);

a process for verifying that the medical information received is accurate and correct by at least vetting said medical information (para. 8 and para. 131 of Segal);

a process for authorizing said senders and said additional receivers according to a set of rules (para. 28 and para. 81 of Segal); and

a transmitter for transmitting a portion of said medical records to one or more additional receivers (para. 20 of Segal); and

authorization for authorizing said senders and receivers according to a set of rules (para. 81 of Segal).

(AA) Referring to claim 47, Segal discloses wherein said database is a secure database (para. 84 of Segal).

(BB) Referring to claim 51, Segal discloses wherein said receiver is selected from the group consisting of: modem, cellular receiver, infrared receiver, Ethernet card, facsimile,

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cable modem, satellite receiver, optical, analog receiver, Internet hub, and web-server (para. 85 of Segal).

(CC) Referring to claim 52, Segal discloses wherein said transmitter is selected from the group consisting of: modem, cellular transmitter, infrared transmitter, Ethernet card, facsimile, cable modem, satellite transmitter, analog transmitter, Internet hub, and web-server (para. 85 of Segal).

(DD) Referring to claim 53, Segal discloses wherein said process of authorizing comprises public key encryption, digital signatures, biometrics, certificate authorities, or user passwords (para. 103 of Segal).

(EE) Referring to claim 54, Segal discloses wherein said portion of said medical records have the characteristic of non-repudiation (para. 8 and para. 131 of Segal).

(FF) Referring to claim 55, Segal discloses wherein said non-repudiated medical records of said one or more subjects are primary for treatment of said one or more subjects by health care providers not involved with creating said medical information (para. 5 and para. 15 of Segal).

(GG) Referring to claim 57, Segal discloses wherein said database is administered by a service provider other than said subjects, senders, and receivers (Fig. 1, item 102, para. 60, and para. 74 of Segal).

(HH) Referring to claim 58, Segal discloses vetting that allows said subjects to supplement said medical records with information relating to the accuracy of said medical records (para. 6 and para. 25 of Segal).

(II) Referring to claim 59, Segal discloses wherein said medical records are owned and controlled by said subjects (para.14 of Segal).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(x) as being unpatentable over Segal et al. (US 2001/0041991 A1) in view of Baker ("PCASSO: A Model for Safe Use of the Internet in Healthcare").

(A) Referring to claim 12, Segal does not disclose wherein the collection comprises medical records of more than 100,000 persons.

Baker discloses wherein the collection comprises medical records of more than 100,000 persons (col. 3, lines 1-4 of Baker).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Baker within Segal. The motivation for doing so would have been to accommodate as large a customer base as possible.

Claims 13-15, 20-22, 25-29, 32-33, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al. (US 2001/0041991 A1) in view of Malik (US 2001/0037219 A1).

(A) Referring to claims 13-15, Segal does not disclose wherein said collection complies with a federal or state standard of privacy and security, wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996, and wherein said collection complies with all state standards of privacy and security for the geographical area in which the system operates.

Malik discloses wherein said collection complies with a federal or state standard of privacy and security, wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996, and wherein said collection complies with all state standards of privacy and security for the geographical area in which the system operates (para. 40 and para. 59 of Malik).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Malik within Segal. The motivation for doing so would have been to allow for communication in a secure environment (para. 40) and to be aware of the laws and regulations governing health care in each jurisdiction (para. 59 of Malik).

(B) Referring to claim 20, Segal discloses a broad-band, computer-based networked system for individual control and management of electronic medical records comprising a plurality of medical records representing a plurality of persons and that the medical

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information of at least one medical record of the plurality has been vetted, such that the medical information of said at least one medical record is better than exists at a source site from which the medical record was obtained and thereby is not subject to repudiation (Fig. 1, para. 11, para. 14, para. 8, and para. 13 of Segal).

Segal does not disclose wherein said plurality of medical records complies with a federal standard of privacy and security.

Malik discloses wherein said plurality of medical records complies with a federal standard of privacy and security (para. 40 of Malik).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Malik within Segal. The motivation for doing so would have been to be aware of the laws and regulations (para. 59 of Malik).

(C) Referring to claim 21, Segal discloses a system that allows for certification of said medical records (para. 131 of Segal; the Examiner interprets "performs quality assurance" to be a form of "certification").

(D) Referring to claim 22, Segal discloses wherein certification represents a predetermined degree of completeness, accuracy or both to said medical records (para. 131 of Segal).

(E) Referring to claim 25, Segal discloses a system which allows for non-repudiation of the medical information of said medical records (para. 8 and para. 131 of Segal).

(F) Referring to claim 26, Segal discloses wherein non-repudiated medical records are primary for treatment of the person to whom each medical record pertains by health care providers (para. 5 and para. 10 of Segal).

(G) Referring to claims 27-28, Segal does not disclose wherein the plurality of medical records complies with the Health Insurance Portability and Accountability Act of 1996 and which further complies with a state standard of privacy and security.

Malik discloses wherein the plurality of medical records complies with the Health Insurance Portability and Accountability Act of 1996 and which further complies with a state standard of privacy and security (para. 40 and para. 59 of Malik).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Malik within Segal. The motivation for doing so would have been to incorporate laws and regulations into the system (para. 59 of Malik).

(H) Referring to claim 29, Segal discloses wherein access to any one medical record is restricted to the person to whom said one medical record pertains or to others designated and authorized by said person (para. 26 and para. 28, lines 1-6 of Segal).

(I) Referring to claims 32 and 33, Segal does not disclose wherein access to the electronic medical record database complies with a federal standard of privacy and security and wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996.

Malik discloses wherein access to the electronic medical record database complies with a federal standard of privacy and security and wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996 (para. 40 of Malik).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Malik within Segal. The motivation for doing so would have been to incorporate laws and regulations into the system (para. 59 of Malik). (J) Referring to claims 48-50, Segal does not disclose wherein said secure database complies with a federal standard of privacy and security, wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996, and which further complies with a state standard of privacy and security.

Malik discloses wherein said secure database complies with a federal standard of privacy and security, wherein the federal standard is the Health Insurance Portability and Accountability Act of 1996, and which further complies with a state standard of privacy and security (para. 40 and para. 59 of Malik).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Malik within Segal. The motivation for doing so would have been to allow for communication in a secure environment (para. 40) and to be aware of the laws and regulations governing health care in each jurisdiction (para. 59 of Malik).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al. (US 2001/0041991 A1) in view of Shear (4,827,508).

(A) Referring to claim 16, Segal does not disclose a fee which is assessed for each access to a medical record.

Shear discloses a fee which is assessed for each access to a medical record (col. 3, lines 3-14 of Shear).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Shear within Segal. The motivation for doing so would have been to charge a fee in accordance with the amount the user has used the system (col. 3, lines 11-14 of Shear).

Claims 18-19 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al. (US 2001/0041991 A1) in view of Ertel (5,307,262).

(A) Referring to claims 18 & 19, Segal does not disclose wherein the medical information of at least one medical record is vetted and wherein the medical information of the vetted medical record contains one or more of: corrections of incorrect information, notations of incorrect information, notations of anomalies, linking of errors, linking of anomalies, notation of discrepancies, linking of discrepancies, and combinations thereof.

Ertel discloses wherein the medical information of at least one medical record is vetted and wherein the medical information of the vetted medical record contains one or more of: corrections of incorrect information, notations of incorrect information, notations of anomalies, linking of errors, linking of anomalies, notation of discrepancies, linking of discrepancies, and combinations thereof (col. 9, lines 1-9 and col. 10, lines 30-37 of Ertel).

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Ertel within Segal. The motivation for doing so would have been to prevent erroneous data from being included in the record (col. 9, lines 4-9 of Ertel).

(B) Referring to claim 31, Segal does not expressly disclose wherein determining accuracy and correctness comprises vetting, identifying or linking errors or inconsistent information, or expunging clear errors in input.

Ertel discloses identifying erroneous data in patient records (col. 9, lines 4-9 of Ertel).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Ertel within Segal. The motivation for doing so would have been to prevent erroneous data from being included in the record (col. 9, lines 4-9 of Ertel).

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al. (US 2001/0041991 A1) in view of Malik (US 2001/0037219 A1) as applied to claim 20 above, and further in view of Ertel (5,307,262).

(A) Referring to claims 23 & 24, Segal and Malik do not disclose a system which allows for vetting of the medical information of said medical records and wherein vetted medical records have been reviewed and corrected or annotated for errors, discrepancies and anomalies.

Ertel discloses a system which allows for vetting of the medical information of said medical records and wherein vetted medical records have been reviewed and corrected or annotated for errors, discrepancies and anomalies (col. 9, lines 1-9 and col. 10, lines 30-37 of Ertel).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Ertel within Segal and Malik. The motivation for doing so would have been to prevent erroneous data from being included in the record (col. 9, lines 4-9 of Ertel).

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segal et al. (US 2001/0041991 A1) in view of Joao (US 6,283,761 B1).

(A) Referring to claim 56, Segal discloses an integrator for reception, display, analysis and modification of said medical records available to be performed on a plurality of systems of health care providers and payors (para. 23, para. 6, and para. 10 of Segal).

Segal does not disclose clearinghouses and oversight agencies.

Joao discloses clearinghouses and oversight agencies (col. 4, line 59 – col. 5, line 6 and col. 27, line 58 – col. 28, line 3 of Joao).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Joao within Segal. The motivation for doing so would have been to facilitate the offering, selling, buying, and/or other transactions involving healthcare-related services (col. 5, lines 1-5 of Joao).

(10) Response to Argument

In the Appeal Brief filed 12 October 2006, Appellant makes the following arguments:

A) Claim 37 should be declared allowable because none of the cited references discloses or suggests, and none of the Examiner's comments materially relates to, a computer networked-system where the medicals records are *more* accurate than the records collected from the source sites where the records originated.

B) The Examiner's analytical approach to Appellant's Affidavit is contrary to the MPEP, and thus clear error.

C) Errors in examining Appellant's claims of "certification" and "non-repudication," particularly a teaching away, show hindsight and violation of the MPEP, so that rejections for failure to disclose the claimed invention and for obviousness must be withdrawn.

D) Applicant's claimed invention, including aspects improperly re-interpreted by the Examiner, is encompassed within the Affidavit sufficiently to swear behind Segal. No more is required of Applicant; Segal must be removed as a prior art reference.

E) All aspects of the Examiner's prior art analysis are error.

F) The Examiner's mutually exclusive interpretations of "accuracy" in relation to "certification" and "non-repudiation" require, inevitably, that Appellant's claims be granted.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Argument A:

In response to Appellant's first argument, the Examiner respectfully submits that Segal discloses various sources from which information is gathered in order to formulate focused medical records (see para. 81 of Segal). In addition, Segal teaches that electronic medical records (EMRs) are "*more* organized, *accurate*, and accessible in comparison to paper-based records" (para. 8 of Segal). Segal also teaches the need "to gather and integrate all records from various physician offices and facilities such as hospitals....to create a focused patient medical record...." (para. 13 of Segal). As such, it is readily apparent that Segal discloses wherein the medical information contained within said medical record is more accurate and correct as compared to those sources (i.e., physician offices) from which the medical records were obtained.

Arguments B and D:

In response to Appellant's second and fourth arguments, the Examiner respectfully submits that Applicant fails to sufficiently show that his invention *as claimed* was completed (i.e., reduced to practice) prior to the date of the applied references. The issue is not whether the affidavit shows more than what the references show, but rather, what invention did Applicant possess as of the dates averred? There is no clear nexus between several of the claimed features and the averred exhibits. For example,

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with respect to the "non-repudiation" feature recited in claim 1, Applicant points to various paragraphs of pp. 4, 8, 10, 11, 12, 13, 17, and 24 of exhibits yet, none of the cited passages directly refers to a "non-repudiation" characteristic. As such, it is unclear as to whether Applicant had possession of such a feature as of the date averred, namely, prior to 2/9/00. Surely, if this feature indeed existed within the invention reduced to practice prior to 2/9/00, there would be undisputable evidence to support such an allegation.

Argument C:

In response to Appellant's third argument, the Examiner gave each term the broadest reasonable interpretation in light of the Applicant's specification. The Examiner referred to the specification, but was unable to find any definition given with precision, clarity, and deliberateness to warrant the meanings currently argued by Applicant. Moreover, words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the Appellant. Where an Appellant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 273 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP § 2111.01. Pursuant to 35 USC § 112, 2nd paragraph

"[i]t is Appellant's burden to precisely define the invention, and not the [examiner's]." *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Therefore, it would **not** be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the Appellant in the written description. In addition, it is noted that where a definition set forth in the written description is merely exemplary (i.e., where Appellant uses the phrase "for example") the Examiner should not consider this a special definition.

In this case, Appellant argues that "certification" is defined in the claims and the specification (pages 15-17). The Examiner respectfully submits that these portions of the specification do not set out a special definition explicitly and with "reasonable clarity, deliberateness, and precision." For example, Appellant recites that "certification may simply state that the record is correct in all material respects or that the record is internally consistent" (page 16, lines 12-13). However, this is not a special definition that has been set out with reasonable clarity, deliberateness, and precision. Instead the definition includes language such as "may" and "may be" which is merely exemplary. For these reasons, Appellant's claims were given their broadest reasonable interpretation consistent with the specification, and has applied prior art accordingly. Similar analysis applies for Applicant's definition of "non-repudiation."

Argument E:

In response to Appellant's fifth argument, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the

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prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner respectfully submits that each limitation was addressed and motivations were provided directly from the applied references throughout prosecution.

Argument F:

In response to Appellant's sixth argument, the Examiner respectfully submits that she gave the terms: "certification" and "non-repudiation," their broadest reasonable interpretation in light of the Applicant's specification. In response to the Examiner's interpretation that "non-repudiation" is the same as "accuracy," Appellant has argued throughout prosecution that "non-repudiation" is not the same as "accuracy." However, in the analysis of Applicant's Affidavit, Appellant appears to state that "accuracy" is in fact, the same as "non-repudiation." As such, if "non-repudiation" is "accuracy," it appears then that Appellant agrees with the Examiner's interpretation of Segal, as applied to the presently recited claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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LN
January 18, 2007

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